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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,682	03/30/2001	Michael Streit	10287-051002 / MGH 1470.2	9232
26161	7590	07/16/2004	EXAMINER YU, MISOOK	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			ART UNIT 1642	PAPER NUMBER

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/822,682	Applicant(s) STREIT ET AL.	
	Examiner MISOOK YU, Ph.D.	Art Unit 1642	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 May 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): none.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.


Claim(s) objected to: _____.

Claim(s) rejected: 82,87-97 and 99-101.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

LARRY R. HELMS, PH.D
PRIMARY EXAMINER


Misook Yu 7/14/04

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant refers to an affidavit or declaration filed in the parent application. Affidavits or declarations, such as those submitted under 37 CFR 1.131 and 37 CFR 1.132, filed during the prosecution of the parent application do not automatically become a part of this application. Where it is desired to rely on an earlier filed affidavit or declaration, the applicant should make the remarks of record in the later application and include a copy of the original affidavit or declaration filed in the parent application.

Since it is now clear that applicant wants to transfer Dr. Detmar's declaration under 37 CFR 1.132 to the instant application, the declaration is a part of this application.

Dr. Detmar's declaration has been fully considered, but the Dr. Detmar's declaration (Paper No. 22) filed under 37 CFR 1.132 filed on 5 September 2003 is insufficient to overcome the rejection of claims 82, 87-97, 100, 101 based upon insufficiency of disclosure under 35 U.S.C. 112, first paragraph as set forth in the last Office action because the claims require making a construct expressing a TSP-2 fragment capable of inhibiting endothelial migration, wherein said fragment comprises at least 10 contiguous amino acids either a procollagen domain of TSP-2 or a type I repeat of TSP-2 for the purpose stated in the preamble of the claims. For example, the data in Fig. 7, which shows Peptide 7 (first type 1 repeat) as the only peptide capable of inhibiting endothelial migration and the rest of peptides comprising at least 10 contiguous amino acids of a procollagen domain of TSP-2 do not have the recited function according to second paragraph at page 45. The specification does not provide guidance how to make a fragment thereof capable of inhibiting endothelial cell migration, wherein said fragment comprises at least 10 contiguous amino acids of a procollagen domain of TSP-2 let alone how to use said fragment in method of treating a tumor.


The argument with data shown at Fig. 3 of the specification and that data shown in the Dr. Declaration is not commensurate in scope of the claims because the claims are not limited to a construct expressing SEQ ID NO:2 or the specific fragment in the declaration. The specification does not teach how to make and use the various products for unpredictable cancer treatment, for example a construct-expressing fragment comprising at least 10 contiguous amino acids either a procollagen domain of TSP-2. The specification does not teach any cell therapy for cancer treatment method using a construct expressing a fragment comprising at least 10 contiguous amino acids a procollagen domain of TSP-2.

Considering unpredictability in the cancer treatment art, broad scope of claims, insufficient guidance with regard using various claimed products to accomplish the purpose stated in the preamble of the claims, it is maintained that undue experimentation would be required to practice the invention as claimed.

Claims 82, 87-99 remain rejected and new claims 100, and 101 are also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant argues that the specification at page 1, lines 10-12, and page 2 lines 19-21, has implicit support "an angiogenesis-dependent tumor". However, the specification has support for unwanted cell proliferation, unwanted angiogenesis, benign or malignant unwanted cell proliferation only. It does not have explicit or implicit support that the instant invention is method of treating "an angiogenesis-dependent tumor". The scope of the claimed invention as originally filed and instantly claimed is different.

Applicant also argues that the specification at page 23 explicitly discloses a fragment that is at least 10 contiguous of TSP-2. The embodiment where the fragment contains a type 1 repeat is only an embodiment, not required for all fragment. Applicant also argues that "procollagen domain is mentioned throughout the specification, thus "at least 10 contiguous amino acids of a procollagen domain" recited in the base claim does not constitute new matter. These arguments have been fully considered but found unpersuasive because the recitation "at least 10 contiguous amino acids of a procollagen domain" changes the scope of the invention the recitation to a narrower scope than the specification as originally disclosed.


LARRY R. HELMS, PH.D
PRIMARY EXAMINER